

Remarks

In response to the Office Action dated September 12, 2006, Applicants respectfully request reconsideration based on the above claim amendment and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance. Claims 2, 4, 5, 7, 10, 11, and 19-24 are currently pending and stand rejected. Claim 20 has been amended.

Interview Summary

A telephone interview was held on November 17 between Applicants' representative, Arno Naeckel, and Examiner Kramer. During the interview it was discussed that page 13-14 of the specification contained a proper written description of the cited claim elements rejected under §112. However, claim 20 will be amended to clarify that the information is provided in an electronic format and when analyzed indicates a cause of the malfunction underlying one of the reports of malfunctions sent from a vicinity of the first subscriber location. The §103 rejection based on Official Notice was also discussed without reaching an agreement. The Examiner requested that clarifying amendments and supporting arguments be submitted.

112 Rejections

Claims 2, 4, 5, 7, 10, 11, and 20-24 stand rejected under 35 USC §112, first paragraph as failing to comply with the written description requirement in that the claims contain subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse the rejections.

As a preliminary matter, Applicants note that claim 19, which depends from claim 20, does not stand rejected under 35 U.S.C. §112 and assume that claim 19 contains allowable subject matter and is in condition for allowance.

Claims 2, 4-5, 7, 10-11, 20-22

The Office Action proceeds by asserting that independent claim 20 recites subject matter not described in the specification. In specific, the office action points to the following recitation:

“...receiving, via a communications network, information sent by the technician upon diagnosing a malfunction at a first subscriber location having a first line number, wherein the information is provided in an electronic format and identifies a cause of the malfunction underlying one of the reports of malfunctions sent from a vicinity of the first subscriber location and wherein the cause is at a location other than the first subscriber location...”¹

The Office Action asserts that the language requires the technician at the first subscriber location to identify the cause of malfunctions at other locations. Applicants disagree and point out that the language recites that the technician “identifies a cause of malfunction underlying one of the reports of malfunctions from the **vicinity of the first subscriber location...**”. The claim language does not recite that the “technician at the first subscriber location identifies the cause of malfunctions at other locations”.

Therefore the recited subject matter does not describe what the Office Action asserts that it describes.

However, in the interest of an efficient prosecution, independent claim 20 has been amended to clarify that “information is provided in an electronic format and when analyzed indicates a cause of the malfunction underlying one of the reports of malfunctions sent from a vicinity of the first subscriber location and wherein the cause is at a location other than the first subscriber location”. Support for the amendment can be found on pages 13-14 of the specification. As such, the Applicants respectfully assert Examiner Error and suggest that the rejection may be withdrawn.

Claims 23-24

The Office Action asserts that claims 23-24 suffer from the same deficiencies under §112, first paragraph as independent claim 20. However, Applicants are unable to find claim language in claim 23 that requires the technician at the first subscriber location

¹ Support for the recitation can be found on page 13-14 of the specification.

to identify the cause of malfunctions at other locations.

However, Applicants believe that the recitation of concern to the Examiner in independent claim 23 actually recites:

“...receiving, via a communications network, information sent by the technician upon diagnosing a malfunction at a first subscriber location that is assigned a first line number, wherein the information is provided in an electronic format and that allows the dispatch division to identify a cause of the malfunction underlying one of the reports of malfunctions sent from a vicinity of the first subscriber location and wherein the cause is at a location other than the first subscriber location, wherein the cost associated with the technician at the first location is recorded in association with the first line number, and wherein the identified cause indicates a range of line numbers that are affected including the first line number...”²

Independent claim 23 does not recite that the **technician** at the first subscriber location identifies the cause of malfunctions at other locations as asserted by the Office Action. As such, Applicants respectfully assert Examiner error as to claims 23 and 24 and suggest that the rejection as to claims 23 and 24 be withdrawn.

103 Rejections

As a preliminary matter, Applicants note that claim 19, which depends from claim 20, does not stand rejected under 35 U.S.C. §103(a) and assume that claim 19 is therefore in condition for allowance.

Claims 2, 4, 5, 7, 10, 11, and 20-24 stand rejected under 35 USC 103(a) as being unpatentable over Pruett (US Pat 5,953,389). It is asserted in the Office Action that Pruett discloses all of the elements except for billing the entity found to be responsible for the cause of the malfunction. However, the Office Action has taken, as if admitted, Official Notice that it is well known in the art to bill the party responsible for all costs incurred. Applicants respectfully traverse these rejections.

The Examiner asserts that Pruett describes that it is possible to determine and to aggregate the costs for each trouble ticket diagnosis when a field technician closes out the trouble report. The Examiner also implies that Pruett then describes determining a responsible party liable for the damage causing the various trouble calls. The Applicants

² Support for the recitation can be found on page 13-14 of the specification.

continue to disagree and reassert that the description in Pruett fails to disclose all of the elements of the claims. Amended independent claim 20 and independent claim 23 each recite similar subject matter. As a representative sample, claim 20 recites,

“[a] method of processing reports of malfunctions received by a company having a dispatch division and a billing division...identifying, by the company, an entity other than a first subscriber of the first subscriber location that is responsible for the cause; and utilizing the information, by the billing division, to generate a bill to the entity other than the first subscriber that includes costs incurred at least for diagnosing the malfunction at the first subscriber location by looking up the range of line numbers associated with the cause for which the entity is responsible, finding that the first line number falls within the range, looking up the costs incurred for the first line number, and including the costs incurred for the first line number on the bill to the entity”.

Applicants assert that even if, for argument sake, it is true that there are direct costs associated with each separate diagnosis reported by one or by several technicians and where the costs of each discrete diagnosis are tracked, there is no description in Pruett that a responsible party is then determined or a responsible party billed for the aggregate of those diagnostic costs.

Further, even assuming, for argument sake, that the Examiner’s Official Notice is correct that car insurance companies bill a third party for the damage the third party caused (usually after significant arbitration or litigation), there still is no description in Pruett that a single bill is determined by analyzing the different line numbers involved with apparently independent symptoms of a common problem. Nor is there a description that the costs incurred by the several technicians in diagnosing those various symptoms should be combined on account of the common cause of the multi-line failure. Pruett merely discloses that the case worker may determine that the entire cable is defective so as to not to dispatch any additional repair technicians. (Col. 40, l. 57-67).

Therefore Applicants reassert that Pruett fails to disclose all of the elements of independent claims 20 and 23 because while Pruett may group alarms to avoid dispatching technicians where the alarms are related to a cause already being addressed, there is no disclosure or suggestion in Pruett that such a grouping is or can be used for the purpose of billing a third party. The grouping, instead, is for making the repair process more efficient by reducing the dispatch of technicians.

Furthermore, the Applicants point out that the deficiencies noted above in regards to Pruett are not cured by the undocumented Official Notice that in the insurance industry a responsible party is billed for all costs incurred, even directly. Applicants assert that the insurance industry does not aggregate repair costs by analyzing line numbers affected by a common problem.

Further still, there is no suggestion in Pruett to adopt a business concept from the non-analogous insurance industry where third parties (i.e. other insurance companies) are usually liable for damages by contract and long standing customs of the trade. Such an insurance concept would not be considered pertinent by one of ordinary skill in the art of billing for a company that dispatches technicians to repair a subscriber line. MPEP 2141.01(a); In Re Clay, 966 F.2d 656 (Fed Circ. 1992).

Official Notice

The Office Action asserts that the Examiner's common knowledge statement made in the Office Action mailed on May 12, 2005 is taken to be admitted prior art because Applicant either failed to traverse the examiner's assertion of Official Notice or the traverse was inadequate. MPEP 2144.03(C). Applicants respectfully challenge the Examiner's presumption of admission.

Applicants respectfully point out that the Applicants specifically traversed the Examiner's Official Notice in detail in Applicants' After Final Response mailed on July 12, 2005. In that response, Applicants specifically pointed out errors in the Examiner's previous action and further indicated that the Examiner was required to produce written authority for his statement. See 37 CFR 1.104(c)(2). The present Office Action merely relies on the Examiner's previous Official Notice, now asserted to be admitted, and an automobile insurance hypothetical which appears to be both non-analogous art and to spring from the Examiner's personal knowledge. If the Examiner is relying on personal knowledge to support his finding of what is known in the art of telecommunications billing, the Examiner is required to provide an affidavit or declaration setting forth specific statements and explanations to support his finding. 37 CFR 1.104(d)(2). The Examiner has failed to do so. If the Examiner is suggesting that the traverse was inadequate, then the Examiner is required to include an explanation as to why the traverse

was inadequate. MPEP 2144.04(c). In any event, Applicants assert that the instant and previous office actions have failed to comply with the requirements for proper use of official notice under MPEP 2144 and the Official Notice must be withdrawn as valid art unless MPEP 2144.04 is complied with.

Conclusion

Applicants respectfully assert that the application including claims 2, 4, 5, 7, 10, 11, and 19-24 is in condition for allowance. Applicants request reconsideration in view of the remarks and amendment above and further request that a Notice of Allowability be provided. Applicants also reiterate their demand for written authority to support the Official Notice assertion or a cogent explanation as to why their traverse was inadequate. Should the Examiner have any questions, please contact the undersigned.

The present Amendment is being filed with a fee payment for a one-month extension of time. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

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